

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Applicants : Robert E. Boyd and James A. Forsyth
Appln. No. : 10/686,353
Filed : October 14, 2003
Title : INSOLE HAVING MULTIPLE ENERGY SOURCES
Docket No. : 066491-00007
Art Unit : 3728
Examiner : Mohandesi

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.131

We, Robert E. Boyd and James A. Forsyth, the inventors of the subject matter presented in the above-identified patent application, declare and say:

1. This declaration is being made to establish invention of the subject matter of the rejected claims in the above-identified patent application prior to the effective date of U.S. Patent No. 7,020,988 to Holden et al. The effective date of U.S. Patent No. 7,020,988 under 35 U.S.C. 102(e) is August 29, 2003. The activities described below took place within the United States, and no activities taking place in any country

DECLARATION UNDER 37 C.F.R. § 1.131
Appln. No. 10/686,353
Docket No. 066491-00007

other than the United States, a NAFTA country, or a WTO member country form the basis of our claim to prior invention.

2. Provided in Appendix A is a copy of a patentability search request dated prior to August 29, 2003 and prepared on our behalf which describes the physical construction and relative rebound properties of an insole such as that claimed in independent claims 1 and 27 of the presently pending application.
3. Provided in Appendix B is a copy of a letter dated prior to August 29, 2003 by the first named inventor authorizing the preparation of a patent application for an insole having two elastomer pads including the hardness and rebound ranges recited in claims 1-3, 27, and 32-33 of the presently pending application.
4. Provided in Appendix C is a copy of a letter dated prior to August 29, 2003 by the first named inventor providing further information including the preferred hardness ranges that are recited in claims 8-9 and 38-41 of the presently pending application.
5. We, the inventors, conceived of the invention recited in the cited claims prior to August 29, 2003. The materials provided in Appendices A-C serve to corroborate a date of conception prior to the effective date of U.S. Patent No. 7,020,988 to Holden et al.
6. Provided in Appendix D is a copy of a letter to a third party dated prior to August 29, 2003 and enclosing a sample of a product embodying the invention of at least independent claim 1, described therein as an "Ultra Sole utilizing spring gel in the forefoot."

7. Provided in Appendix E are copies of business records documenting sales of a product embodying the invention of at least independent claim 1, marketed as the "NRG Ultra Sole," comprising: (page 1) a factory order dated July 21, 2003 for 6600 units; (page 2) a picking ticket documenting shipment of 200 units on July 21, 2003; (page 3) an invoice billing the shipment released on July 21, 2003; (page 4) a picking ticket documenting shipment of 4725 units on July 31, 2003; and (page 5) an invoice billing the shipment released on July 31, 2003.
8. We, the inventors, reduced the claimed invention to practice on or before July 21, 2003 through sales of an embodiment of the invention to an unrelated third party. The materials provided in Appendices A-E serve to corroborate conception of the invention prior to the effective date of U.S. Patent No. 7,020,988 coupled with an actual reduction to practice prior to August 29, 2003.
9. Provided in Appendix F is a copy of a letter dated September 5, 2003 enclosing a draft patent application for review by the named inventors.
10. Provided in Appendix G is a copy of a letter dated October 8, 2003 by the first named inventor, on behalf of both inventors, approving the draft application received with the letter included in Appendix F and ordering the filing of the above-indicated patent application.
11. We, the inventors, acted with due diligence from prior to August 29, 2003 to the filing of the above-identified patent application on October 14, 2003. This diligence included ordering the preparation of a patent application, reviewing the draft patent application, and ordering the filing of the approved draft patent application. The materials provided in Appendices A-G serve to corroborate conception of the

DECLARATION UNDER 37 C.F.R. § 1.131

Appl. No. 10/686,353

Docket No. 066491-00007

invention prior to the effective date of U.S. Patent No. 7,020,988 coupled with due diligence from prior to August 29, 2003 to the filing of the above-identified patent application.

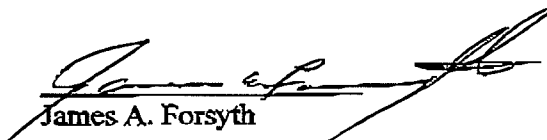
12. We, the inventors, further declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.



Robert E. Boyd

6-13-07

Date



James A. Forsyth

6-13-07

Date

449591.1

DECLARATION UNDER 37 C.F.R. § 1.131

Appln. No. 10/686,353

Docket No. 066491-00007

Appendix A

SAND & SEBOLT

A LEGAL PROFESSIONAL ASSOCIATION

LEGIS TOWER
SUITE 1100
400 MUNSON STREET, NW
CANTON, OHIO 44718-3615

TELEPHONE: (330) 244-1174
FAX: (330) 244-1173
EMAIL: INFO@SANDSEBOLT.COM

PATENT, TRADEMARK, COPYRIGHT LAW
& RELATED LITIGATION

JOSEPH A. SEBOLT
FREDERICK H. ZOLLINGER, III
LAURA L. BEOGLOS
CLAY H. CUNNINGHAM

MICHAEL SAND
JAMES F. McCARTHY, III
Of Counsel

RE: Patent Search
INSOLE HAVING MULTIPLE
ENERGY SOURCES

Dear [REDACTED]:

Our client would like to conduct a patentability search for an insole product having multiple energy components. Most notably, the unit would provide an insole having an elastomer, which would not be foam, with a first spring rate, and then tailored to the type of sport for which the insole will be used, a second more energy absorbing spring rate will be provided. The second energy absorbing spring rate material could be provided adjacent the heel or the ball of the foot to take impact from a runner, or along the side of the insole to take impact from side load as a result of movements during the sport of tennis. Additionally, a device could be provided having an impact absorbing material with a low spring rate, and therefor very impact absorbing at the heel of a runner's insole, and a material with a high spring rate adjacent the ball of the user's foot to urge the user's foot upwardly after impact, causing the runner to experience less weight load during running, while simultaneously allowing the insole to absorb high impact at heel load. The elastomers would normally be of a gel or semi-gel type, and would be mounted within a carrier manufactured of any elastomer foam or fabric such as shown on the attached sheet.

Yours truly,

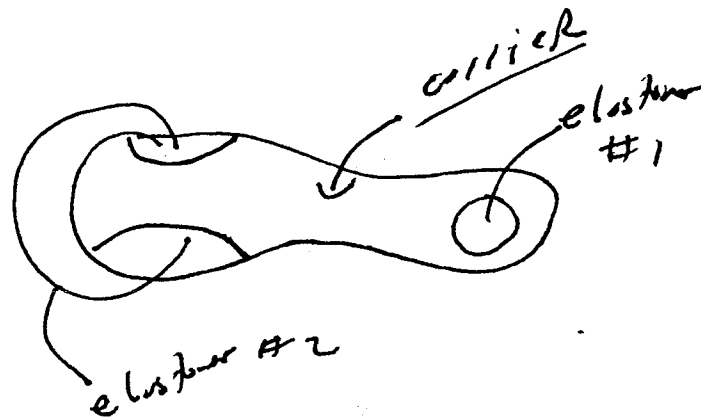
SAND & SEBOLT



By: Joseph A. Sebolt

JAS/tmg
Encl.

From the desk of Joe Sebolt...



DECLARATION UNDER 37 C.F.R. § 1.131
Appln. No. 10/686,353
Docket No. 066491-00007

Appendix B



[REDACTED]

Joe Sebolt
SAND & SEBOLT
Aegis Tower
4940 Munson St. N.W., Suite 1100
Canton, OH 44718

SUBJECT: Multi Elastomer Insole

Dear Joe,

[REDACTED]

I would suggest that you use our patent number 4808469 as a guide in comprising the elements you feel necessary to seek patent approval on this new insole product.

Suggested name: Multi-gel Elastomer Composite Insole

Insole is to be comprised of two or more elastomers with different rates of energy absorbing properties and/or rebound properties.

Elastomer #1 having a density from .7 to 2.0 and a durometer ranging from 20 to 70 durometer, shore 00 scale and having a rebound rate 1% to 40%.

Elastomer #2 having a density from .8 to 2.2 and durometer range from 30 to 70 durometer, shore 00 scale and having a rebound rate from 5% to 90%.

The intent of the composite insole is to absorb energy in designated areas of the foot and return energy in designated areas of the foot, at varying rates.

[REDACTED]

Sincerely,

SORBOTHANE, INC.



Robert E. Boyd
President

Cc: Jim Forsyth



2144 State Rt. 59 • Kent, Ohio 44240 • www.sorbothane.com
800-838-3906 • Phone (330) 678-9444 • Fax (330) 678-1303

DECLARATION UNDER 37 C.F.R. § 1.131

Appln. No. 10/686,353

Docket No. 066491-00007

Appendix C



[REDACTED]

Joe Sebolt
SAND & SEBOLT
Aegis Tower
4940 Munson St., N.W., Suite 100
Canton, OH 44718

[REDACTED]

SUBJECT: Multi Elastomer Insole

Dear Joe,

[REDACTED]

[REDACTED] you could
change the durometer range on Elastomer #1 to read having a density of .7 to 2.0 and a
durometer range of 20 to 55, shore 00 scale and having a rebound rate of 1% to 40%.
Elastomer #2 to read having a density from .8 to 2.2 and a durometer range from 35 to 70
durometer, shore 00 scale and having a rebound of 5 – 90% .

[REDACTED]

Sincerely,

SORBOTHANE, INC.

Robert E. Boyd
President

REB:djw

cc: JimForsyth



2144 State Rt. 59 • Kent, Ohio 44240 • www.sorbothane.com
800-838-3906 • Phone (330) 678-9444 • Fax (330) 678-1303

DECLARATION UNDER 37 C.F.R. § 1.131
Appln. No. 10/686,353
Docket No. 066491-00007

Appendix D



[Redacted]

[Redacted]

Subject: Sorbothane Ultra Sole Spring Gel

Dear [Redacted]

Confirming our conversation, the following is a quote on the new Ultra Sole utilizing a Spring Gel in the forefoot:

[Redacted]

[Redacted] we will be getting some additional samples to you and, bear in mind these are prototypes; as we zero in on the color and coverings, we can produce more sample product accordingly.

Also attached is a listing of potential marketing names for this new Ultra product.

Sincerely,

SORBOTHANE, INC.

Bob

Robert E. Boyd
President

Enclosures

Cc: Jim Forsyth
Sue Freilino



2144 State Rr. 59 • Kent, Ohio 44240 • www.sorbothane.com
800-838-3906 • Phone (330) 678-9444 • Fax (330) 678-1303

SORBOTHANE
COST ESTIMATE

Quote No.: SORBO ULTRA SOLES
Customer: SORBOTHANE *Spains Gel*
Cu. Inch/Part: _____
Cavities/Mold: _____
No. of Molds: 38

Part No. _____
Date: _____
Gram: _____
Durometer: _____
Pour/Hour: _____

MATERIALS

Scrap % 10.0%

Description	
SORBOTHANE	
FOAM	
PORON	
SPRING GEL	
Total	

Description: ULTRA SOLE BULK with Spains Gel in Forefoot

DECLARATION UNDER 37 C.F.R. § 1.131
Appln. No. 10/686,353
Docket No. 066491-00007

Appendix E

P I C K I N G T I C K E T

NUMBER ORDER DATE CUSTOMER NO. CUST. P.O. NO. CUSTOMER TERMS

SHIP-VIA
PSSHIP-DATE SHIPPING INSTRUCTIONS
A.S.A.P.

Sold To:

Ship To:

Qty To Ship	Request Date	Item Number / Description	UoM	Qty Picked
450	07/21/2003	0181810 NRG ULTRA SOLE/RED GEL - A 50 DURO 280 BLUE/280 PORON	EA	_____
900	07/21/2003	0181820 NRG ULTRA SOLE/RED GEL - B 50 DURO 280 BLUE/280 PORON	EA	_____
900	07/21/2003	0181830 NRG ULTRA SOLE/RED GEL - C 50 DURO 280 BLUE/280 PORON	EA	_____
850	07/21/2003	0181840 NRG ULTRA SOLE/RED GEL - D 50 DURO 280 BLUE/280 PORON	EA	_____
1,500	07/21/2003	0181850 NRG ULTRA SOLE/RED GEL- E 50 DURO 280 BLUE/280 PORON	EA	_____
1,400	07/21/2003	0181860 NRG ULTRA SOLE/RED GEL - F 50 DURO 280 BLUE/280 PORON	EA	_____
550	07/21/2003	0181870 NRG ULTRA SOLE/RED GEL - G 50 DURO 280 BLUE/280 PORON	EA	_____
50	07/21/2003	0181880 NRG ULTRA SOLE/RED GEL - H	EA	_____

P I C K I N G T I C K E T

NUMBER ORDER DATE CUSTOMER NO. CUST. P.O. NO. CUSTOMER TERMS

SHIP-VIA
UPSSHIP-DATE
A.S.A.P.

SHIPPING INSTRUCTIONS

d To:

Ship To:

7/21/03

y To Ship	Request Date	Item Number / Description	UoM	Qty Picked
450	07/21/2003	0181810 NRG ULTRA SOLE/RED GEL - A 50 DURO 280 BLUE/280 PORON	EA	<u>Ø</u>
900	07/21/2003	0181820 NRG ULTRA SOLE/RED GEL - B 50 DURO 280 BLUE/280 PORON	EA	<u>Ø</u>
900	07/21/2003	0181830 NRG ULTRA SOLE/RED GEL - C 50 DURO 280 BLUE/280 PORON	EA	<u>Ø</u>
850	07/21/2003	0181840 NRG ULTRA SOLE/RED GEL - D 50 DURO 280 BLUE/280 PORON	EA	<u>Ø</u>
1,500	07/21/2003	0181850 NRG ULTRA SOLE/RED GEL- E 50 DURO 280 BLUE/280 PORON	EA	<u>200</u>
1,400	07/21/2003	0181860 NRG ULTRA SOLE/RED GEL - F 50 DURO 280 BLUE/280 PORON	EA	<u>Ø</u>
550	07/21/2003	0181870 NRG ULTRA SOLE/RED GEL - G 50 DURO 280 BLUE/280 PORON	EA	<u>Ø</u>
50	07/21/2003	0181880 NRG ULTRA SOLE/RED GEL - H	EA	<u>Ø</u>

Ø

INVOICE

No. 1010 / 1
INVOICE DATE
07/22/03

2144 State Rt. 59 • Kent, Ohio 44240
(330) 678-9444 Fax (330) 678-1303

TORG

Inc

PLEASE REMIT TO:

TRELLEBORG CORP.
22029 NETWORK PLACE
CHICAGO, IL 60673-1220

SOLO
TO

SHIP
TO

QTY. ORDER/B.O.	QTY. SHIP/RETURN	ITEM NO/DESCRIPTION	UNIT PRICE	UOM DISC	NET PRICE
450		0181810		EA	.00
450		NRG ULTRA SOLE/RED GEL - A			
		50 DURO 280 BLUE/280 PORON			
900		0181820		EA	.00
900		NRG ULTRA SOLE/RED GEL - B			
		50 DURO 280 BLUE/280 PORON			
900		0181830		EA	.00
900		NRG ULTRA SOLE/RED GEL - C			
		50 DURO 280 BLUE/280 PORON			
850		0181840		EA	.00
850		NRG ULTRA SOLE/RED GEL - D			
		50 DURO 280 BLUE/280 PORON			
1,500	200	0181850		EA	
1,300		NRG ULTRA SOLE/RED GEL- E			
		50 DURO 280 BLUE/280 PORON			
1,400		0181860		EA	.00
1,400		NRG ULTRA SOLE/RED GEL - F			
		50 DURO 280 BLUE/280 PORON			
550		0181870		EA	.00
550		NRG ULTRA SOLE/RED GEL - G			
		50 DURO 280 BLUE/280 PORON			
50		0181880		EA	.00
50		NRG ULTRA SOLE/RED GEL - H			
COMMENTS			SALE AMOUNT		
TERMS			MISC. CHARGES		
			FREIGHT		
			SALES TAX		
			TOTAL		
CUSTOMER SERVICE			AMOUNT RECEIVED		
			BALANCE DUE		

P I C K I N G T I C K E T

NUMBER ORDER DATE CUSTOMER NO. CUST. P.O. NO. CUSTOMER TERMS

P-VIA SHIP-DATE SHIPPING INSTRUCTIONS
A.S.A.P.

To:

Ship To:

7/31/03

To Ship	Request Date	Item Number / Description	UoM	Qty Picked
450	07/21/2003	0181810 NRG ULTRA SOLE/RED GEL - A 50 DURO 280 BLUE/280 PORON	EA	<u>375</u>
900	07/21/2003	0181820 NRG ULTRA SOLE/RED GEL - B 50 DURO 280 BLUE/280 PORON	EA	<u>425</u>
900	07/21/2003	0181830 NRG ULTRA SOLE/RED GEL - C 50 DURO 280 BLUE/280 PORON	EA	<u>625</u>
850	07/21/2003	0181840 NRG ULTRA SOLE/RED GEL - D 50 DURO 280 BLUE/280 PORON	EA	<u>850</u>
900	07/21/2003	0181850 NRG ULTRA SOLE/RED GEL - E 50 DURO 280 BLUE/280 PORON	EA	<u>900</u>
1000	07/21/2003	0181860 NRG ULTRA SOLE/RED GEL - F 50 DURO 280 BLUE/280 PORON	EA	<u>950</u>
1500	07/21/2003	0181870 NRG ULTRA SOLE/RED GEL - G 50 DURO 280 BLUE/280 PORON	EA	<u>550</u>
50	07/21/2003	0181880 NRG ULTRA SOLE/RED GEL - H	EA	<u>50</u>

0

INVOICE

No. 10104247

INVOICE DATED

ORG
ne Inc2144 State Rt. 59 • Kent, Ohio 44240
(330) 678-9444 Fax (330) 678-1303PLEASE REMIT TO: TRELLEBORG CORP.
22029 NETWORK PLACE
CHICAGO, IL 60673-1220SHIP
TO

ORDER NO.	ORDER DATE	CUSTOMER NO.	LOC.	SLSMN	PURCHASE ORD. NO.	JOB NUMBER	SHIP VIA	COL/PPD
	07/21/03		OH	900			UPS	

QTY. ORDER/V.O.	QTY. SHIP/RETURN	ITEM NO./DESCRIPTION	UNIT PRICE	UOM DISC.	NET PRICE
450 75	375	0181810 NRG ULTRA SOLE/RED GEL - A 50 DURO 280 BLUE/280 PORON		EA	
900 475	425	0181820 NRG ULTRA SOLE/RED GEL - B 50 DURO 280 BLUE/280 PORON		EA	
900 275	625	0181830 NRG ULTRA SOLE/RED GEL - C 50 DURO 280 BLUE/280 PORON		EA	
850	850	0181840 NRG ULTRA SOLE/RED GEL - D 50 DURO 280 BLUE/280 PORON		EA	
1,300 400	900	0181850 NRG ULTRA SOLE/RED GEL - E 50 DURO 280 BLUE/280 PORON		EA	
1,400 450	950	0181860 NRG ULTRA SOLE/RED GEL - F 50 DURO 280 BLUE/280 PORON		EA	
550	550	0181870 NRG ULTRA SOLE/RED GEL - G 50 DURO 280 BLUE/280 PORON		EA	
50	50	0181880 NRG ULTRA SOLE/RED GEL - H		EA	

COMMENTS

SALE AMOUNT

MISC. CHARGES

FREIGHT

SALES TAX

TOTAL

AMOUNT RECEIVED

BALANCE DUE

TERMS

CUSTOMER SERVICE

DECLARATION UNDER 37 C.F.R. § 1.131

Appln. No. 10/686,353

Docket No. 066491-00007

Appendix F

SAND & SEBOLT

A LEGAL PROFESSIONAL ASSOCIATION

AEGIS TOWER
SUITE 1100
4940 MUNSON STREET, NW
CANTON, OHIO 44718-3615

PATENT, TRADEMARK, COPYRIGHT LAW
& RELATED LITIGATION

JOSEPH A. SEBOLT
FREDERICK H. ZOLLINGER, III
LAURA L. BEOGLOS
CLAY H. CUNNINGHAM

TELEPHONE: (330) 244-1174
FAX: (330) 244-1173
E-MAIL: INFO@SANDSEBOLT.COM

MICHAEL SAND
JAMES F. MCCARTHY, III
Of Counsel

September 5, 2003

Mr. Robert E. Boyd, President
SORBOTHANE, INC.
2144 State Rt. 59
Kent, OH 44240

Re: U.S. Patent Application
INSOLE HAVING MULTIPLE ENERGY SOURCES
Our File: 2021012US1AP

Dear Bob:

Please review the enclosed patent application for the above-referenced invention.



I look forward to hearing from you. Please call with any questions.

Sincerely,

SAND & SEBOLT



By: Joseph A. Sebolt

JAS/CHC/kab
Enclosures

DECLARATION UNDER 37 C.F.R. § 1.131
Appln. No. 10/686,353
Docket No. 066491-00007

Appendix G

Sorbothane Inc.

Innovations In Advanced Polymer Technology

RECEIVED
OCT 10 2003
SAND & SEBOLT

October 8, 2003

Joseph A. Sebolt
SAND & SEBOLT
Aegis Tower, Suite 1100
4940 Munson Street NW
Canton, OH 44718-3615

Subject: US Patent Application
INSOLE HAVING MULTIPLE ENERGY SOURCES
File No. 2021012US1AP

Dear Joe,



Please submit to the patent office as written.

Sincerely,

SORBOTHANE, INC.

A handwritten signature in cursive script that reads "Bob".

Robert E. Boyd
President

REB:djw

Enclosure